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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,392	11/18/2005	Werner Jacob	JACOB W ET AL 3 PCT	6165
25889 7590 09/17/2007 WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER BINDA, GREGORY JOHN	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 09/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,392	Applicant(s) JACOB ET AL.	
	Examiner Greg Binda	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4,6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/14/05 11/18/05</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of the sliding articulation shown in Figs. 5 & 6 (Species III) in the reply filed on August 20, 2007 is acknowledged. The traversal is on the ground(s) that

a. The traversal is on the grounds that a search for the elected species would necessarily require a search of the unelected species. This is not found persuasive because: (1) the search required for the elected species would not include a search for the unelected species since the structural difference between the species would necessitate additional search, and (2) examination is not simply limited to search. In addition to the search, much of the examination is devoted to determining patentability of claims. Said determination requires the formulation of rejections and responding to applicant's arguments with regard to same. The additional search and the determination of patentability for multiple, patentably distinct species would place serious burden on the examiner.

b. The traversal is on the grounds that the election requirement necessitates the filing of multiple patent applications. This is not found persuasive because there is no need to file multiple applications. Multiple filings could be avoided by presenting an allowable generic claim(s) and/or stipulating that the species are obvious in view of each other.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 4, 6 & 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on August 20, 2007.

Claim Objections

3. The claims are objected to as failing to comply with 37 CFR 1.75(i) because elements of the claims are not separated by line indentation.
4. Claim 5 objected to because the limitation, “the ridges (17)” should be changed to “ridges (17)” since these ridges are not previously recited.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 & 8-11 rejected under 35 U.S.C. 102(b) as being anticipated by Cull et al, US 3,452,558 (Cull). Cull discloses in col. 2, line 22 through col. 3, line 6; col. 4, line 52 through col. 5, line 57 and Figs. 1-4 a sliding articulation comprising every limitation of the claims.

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7. Claims 1-3, 8, 9 & 11 rejected under 35 U.S.C. 102(b) as being anticipated by Perrow, US 2001/0049309. Perrow discloses in paragraphs 34-36 and Fig. 5 a sliding articulation comprising every limitation of the claims.

8. Claims 1-3 & 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cermak et al, US 2001/0018369 (Cermak). Figs. 1-4 show a sliding articulation comprising:

an outer hub 3 that encloses a cavity 4 and has raceways 5 in its inner surface, which extend parallel to the axis 'x' of the sliding articulation;

an inner hub 1 accommodated in the cavity, which has raceways 10 on its outer surface, which extend parallel to the axis of the sliding articulation and lie opposite the raceways of the outer hub, and accommodate a ball 15 together with these, in pairs in each instance; and

a cage 16 disposed between the outer hub and the inner hub, which guides the balls in an axial direction,

wherein the inner hub is freely displaceable relative to the outer hub (see first sentence of paragraph 0032) in the axial direction, between a first stop 6 and a second stop 9 over a first distance by means of rolling the balls in the raceways (see second sentence of paragraph 0032) and displaceable over an additional distance by means of sliding of the balls in the raceways (see paragraph 0033, lines 7+). As evident from paragraph 0034 and Fig. 4, the movement of the balls 15 is limited not only by the stops 6 & 9 in the outer hub 3, but instead, at least by one split ring 11, 12 inserted in the raceway 10 of the inner hub 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cermak in view of Croset, US 3,488,979. Cermak shows a sliding articulation comprising a folding cage 16, but does not show the cage having guide ridges that engage centering grooves in ridges between the raceways of the inner hub. In Figs. 1 & 3, Croset shows a cage 39 having guide ridges 60A-60C that engage centering grooves 67 in ridges between the raceways 35 of the inner hub 10. In col. 3, lines 65+, Croset teaches providing the cage with guide ridges engaging centering grooves in the inner hub in order to provide a means to maintain the cage in its correct position. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the sliding articulation of Cermak by providing the cage with guide ridges engaging centering grooves in the inner hub in order to provide a means to maintain the cage in its correct position as taught by Croset.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greg Binda
Primary Examiner
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